

REMARKS

Applicants submit this Reply to Final Office Action mailed June 6, 2007. Prior to this Reply, claims 45-88 were submitted for examination. In this Reply, Applicants have cancelled claims 45, 80, 81, and 82 without prejudice or disclaimer. Therefore, claims 46-79 and 83-88 are currently pending, of which claim 84 is independent.

In the Office Action, the Examiner rejected claims 45-51, 55, 57-62, 64-66, 73, 75, 84-86 and 88 under 35 U.S.C. § 102(b) as being anticipated by PCT Application WO 98/52197 ("197"); rejected claims 45-51, 54-56, 58, 61-67, 71-73, 75, 84-86, and 88 under 35 U.S.C. § 102(b) as being anticipated by PCT Application WO 99/33070 ("070"); rejected claims 45-62, 64-70, 74, and 75 under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. Pub. No. 2005/0046073 ("Balconi"); and rejected claims 52, 53, 76-84, 86, and 87 under 35 U.S.C. § 103(a) as being unpatentable over '197'.

In this Reply, Applicants have cancelled independent claims 45 and 80 without prejudice or disclaimer, have amended previously independent claim 76 such that it now depends from independent claim 84, and amended independent claim 84. Claim 84, the sole independent claim submitted for examination, now recites, among other things:

determining a thickness for said insulating layer compatible with safe operation in a predetermined voltage class on said selected conductor cross-sectional area based on one of a plurality of predetermined electrical limit conditions and being smaller than the insulating layer thickness provided for in IEC Standard 60502-2 (Ed. 1.1-1998-11) for the corresponding voltage class [and] said insulating layer thickness being such as to provide a voltage gradient on the outer surface of the insulating layer not smaller than 1.0 kV/mm

Support for this amendment can be found in Applicants' specification at least at page 7, lines 16-29, page 8, lines 17-22, and original claims 1 and 7.

Applicants respectfully traverse all pending rejections for at least the reasons discussed below.

Rejections Under 35 U.S.C. § 102

Applicants respectfully traverse the rejection of claims 45-51, 55, 57-62, 64-66, 73, 75, 84-86 and 88 under 35 U.S.C. § 102(b) as being anticipated by '197'; the rejection of claims 45-51, 54-56, 58, 61-67, 71-73, 75, 84-86, and 88 under § 102(b) as being anticipated by '070'; and the rejection of claims 45-62, 64-70, 74, and 75 under § 102(e) as being anticipated by Balconi. In order to properly establish that either '197', '070', or Balconi anticipates Applicants' claimed invention under 35 U.S.C. § 102, every element of the claims in issue must be found, either expressly or described under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Neither '197', '070', or Balconi disclose every element of Applicants' claimed invention. Independent amended claim 84 recites, in part, "a thickness for said insulating layer . . . being smaller than the insulating layer thickness provided for in IEC Standard 60502-2 (Ed. 1.1–1998-11) for the corresponding voltage class [and] said insulating layer thickness being such as to provide a voltage gradient on the outer surface of the insulating layer not smaller than 1.0 kV/mm." None of the references cited by the Examiner discloses either of these features.

'197', '070', and Balconi all disclose a cable comprised of an insulating layer, an expanded polymer layer, and a non-expanded layer (or sheath). Specifically, '197

discloses the use of an expanded polymer material in order to add impact strength to a cable; '070 teaches the use of a semi-conductive expanded layer to prevent the penetration and propagation of moisture within a cable and prevent deformations or breakages in the cable due to the cable's thermal cycles; and Balconi discloses a method whereby an expanded polymeric layer and a non-expanded polymeric layer can be co-extruded without the risk of bubbles forming between the two layers. But none of the references cited by the Examiner teaches an insulating layer thickness "being smaller than the insulating layer thickness provided for in IEC Standard 60502-2 (Ed. 1.1–1998-11) for the corresponding voltage class." Further, none of the references cited by the Examiner teaches an insulating layer thickness "being such as to provide a voltage gradient on the outer surface of the insulating layer not smaller than 1.0 kV/mm."

Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejections of claim 84 based upon '197, '070, and Balconi under 35 U.S.C. § 102. Moreover, claims 46-51, 55, 57-62, 64-66, 73, 75, 85, 86, and 88 depend from claim 84 and, thus, contain all the elements and limitations thereof. As a result, dependent claims 46-51, 55, 57-62, 64-66, 73, 75, 85, 86, and 88 are allowable at least due to their corresponding dependence from independent claim 84.

Rejections Under 35 U.S.C. § 103(a)

The Examiner rejected claims 52, 53, 76-84, 86, and 87 under 35 U.S.C. § 103(a) as being unpatentable over '197. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006).

Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, ‘197 neither teaches nor suggests every feature of amended independent claim 84. Applicants have already established in the previous section that ‘197 fails to teach or suggest “a thickness for said insulating layer . . . being smaller than the insulating layer thickness provided for in IEC Standard 60502-2 (Ed. 1.1–1998-11) for the corresponding voltage class [and] said insulating layer thickness being such as to provide a voltage gradient on the outer surface of the insulating layer not smaller than 1.0 kV/mm,” as recited in independent amended claim 84.

For at least this reason, claim 84 is patentable under 35 U.S.C. § 103(a) over ‘197. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the rejection of claim 84 under 35 U.S.C. § 103(a). Moreover, claims 52, 53, 76-79, 83, 86, and 87 depend from claim 84 and, thus, contain all the elements and limitations thereof. As a result, dependent claims 52, 53, 76-79, 83, 86, and 87 are allowable at least due to their corresponding dependence from independent claim 84.

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants believe that Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Summary

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 4, 2007

By: 

Benjamin D. Bailey
Reg. No. 60,539